

REMARKS

Claim 1 is amended. New claims 18 and 19 are added. Claims 1-19 remain in the application. Reconsideration of the application in view of the amendments and the remarks to follow is requested.

Claims 1, 2, 15 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada et al. (4,662,717) in view of Jonas et al. (WO 99/40469).

Claims 3-14 and 17 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

New claim 18 is rewritten claim 1 to include the limitations of objected to claim 3, and therefore, claim 18 is allowable. Applicant respectfully requests allowance of claim 18 in the next office action.

Claim 19 is rewritten original claim 1 to include the limitations of objected to claim 5, and therefore, claim 19 is allowable. Applicant respectfully requests allowance of claim 19 in the next office action.

Regarding the obviousness rejection against claim 1 based on the combination of Yamada and Jonas, such claim is amended to recite bearing members are provided with spherical surface directed toward support points.

wherein an optical element freely rests upon the bearing members. No new matter is added as the originally-filed application supports the amendment language at, for example, Figs. 1 and 5-6.

Yamada teaches lens 50 can be secured to a lens barrel 40 by fitting joint protrusions 53 into depressions 43 (col. 7, Ins. 25-33) wherein the protrusions 53 are forced into depressions 43 so that lens 50 and lens barrel 40 are **closely fitted** to each other and are prevented from separating due to such mating (col. 7, Ins. 40-55). The Abstract of Jonas fails to provide any teachings to how optical component 2 is mounted to variator 1 (abstract). Accordingly, in no fair or reasonably interpretation does the combination of Yamada and Jonas, in any combination, teach or suggest an optical element **freely rests** upon the bearing members as recited in claim 1. Therefore, Yamada and Jonas, in any combination, fail to teach or suggest a positively recited limitation of claim 1. For this reason, claim 1 is allowable. Applicant respectfully requests allowance of claim 1 in the next office action.

Claims 2-17 depend from independent claim 1, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well

as for their own recited features which are not shown or taught by the art of record.

Moreover, the combination of Yamada and Jonas is improper, and therefore, the obviousness rejection based upon the combination must fail. The Examiner states that Yamada does not specifically disclose bearing members having a spherical surface, and therefore, relies on Jonas to teach a ball 13 that runs on a stationary guide way 5 (abstract) to allegedly provide the deficiency in teachings of Yamada (pg. of paper no. 6). That is, the Examiner is suggesting modifying a structure for fitting a lens to a lens holding device (protrusions 53 forced into depressions 43) with a ball structure used in a guide for adjusting an optical component. Respectfully, the ball structure of Jonas **has no relevance** to fitting a lens to a lens holding device, and therefore, one skilled in the art would have no motivation to look to teachings of Jonas for the Examiner's suggested modification of the Yamada invention. Accordingly, the Examiner's logic for relying on the teachings of Jonas to modify the Yamada invention fails, and therefore, for at least this reason, the obviousness rejection based on the combination of Yamada and Jonas must fail.

The Examiner is respectfully reminded that if the proposed modification or combination of the prior art would change the principal of operation in the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. MPEP §2143.01 (8th Edition) *citing to In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The court in *In re Ratti* reversed a rejection holding the "suggested combination of references would require substantial reconstruction and redesign of elements shown in the [primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate" 270 F.2d at 813, 123 USPQ at 352. Since the Examiner is suggesting modifying a structure for fitting a lens to a lens holding device (protrusions 53 forced into depressions 43) with a ball structure used in a guide for adjusting an optical component, it is inconceivable that such modification of Yamada would not require substantial reconstruction and redesign of elements shown in the primary reference of Yamada as well as change the basic principal in which the Yamada construction was designed to operate. Therefore, pursuant to the above authority, such modification is inappropriate and does not provide a *prima facie* basis for an obviousness rejection. For this additional reason, the obviousness rejection fails.

Moreover, the Examiner presents the motivational rationale for the combination stated as: it would be obvious to one skilled in the art to make the joining member spherical as shown in Jonas to ensure the best possible interconnection between the mount and the lens for securing the two together (pg. 2 of paper no. 6). However, in no fair or reasonable interpretation is the ball of Jonas a joining member to interconnect a lens to mount as Jonas clearly discloses the ball structure is part of a guide structure. Consequently, the logic of the Examiner's motivational rationale fails. For this additional reason, the obviousness rejection fails and should be withdrawn.

For all the above reasons, Applicant respectfully requests withdrawal of the obviousness rejection against claims 1, 2, 15 and 16 based on the combination of Yamada and Jonas in the next office action.

In view of the foregoing, allowance of all pending claims is requested. This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such

subsequent action.

Respectfully submitted,

Dated: 2-21-8

By: [Signature]

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Reg. No. 40,045



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 09/882,564
Filing Date June 15, 2001
Inventor Karlfrid Osterried
Assignee Carl-Zeiss-Stiftung trading as Carl Zeiss
Group Art Unit 2873
Examiner T.J. Thompson
Attorney's Docket No. LO26-002
Title: Device for Mounting an Optical Element, For Example a Lens Element in a Lens

VERSION WITH MARKINGS TO SHOW CHANGES MADE
ACCOMPANYING RESPONSE TO NOVEMBER 20, 2002 OFFICE ACTION

In the Claims

The claims have been amended as follows. Underlines indicate insertions
and ~~strikeouts~~ indicate deletions.

1. (Amended) A device for mounting an optical element, for example a lens element in a lens, especially in an exposure lens in micro lithography, having the following features:

- a) the optical element is provided in its edge zone with support points,
- b) counterbearing points are disposed opposite the support points of the optical element in an outer mounting,
- c) bearing members are disposed between the support points and the counterbearing points, and
- d) the bearing members are provided with spherical surfaces directed toward the support points, wherein the optical element freely rests upon the bearing members.

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